

REMARKS

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Official Action dated March 1, 2004. In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

Status of the Claims

Claims 1-20 are under consideration in this application. Claims 1, 11, 15, 17 and 19-20 are being amended, as set forth in the above marked-up presentation of the claim amendments, in order to more particularly define and distinctly claim applicants' invention.

Additional Amendments

The claims are being amended to correct formal errors and/or to better disclose or describe the features of the present invention as claimed. All the amendments to the claims are supported by the specification. Applicants hereby submit that no new matter is being introduced into the application through the submission of this response.

Formality Rejection

Claims 11, 12, 19 and 20 were objected to for a typing error. As indicated, the claims have been amended as required by the Examiner. Accordingly, the withdrawal of the outstanding informality rejection is in order, and is therefore respectfully solicited.

Allowable Subject Matter

Claims 11, 12 and 20 were allowed, and claim 19 would be allowed if it is rewritten in independent form to include all the limitations of the base claims and any intervening claims. Claim 19 is being rewritten in independent form to include all of the limitations of the base claim and any intervening claims such that they are in condition for allowance.

Prior Art Rejections

Claims 1-3, 5-10, 13, 14 and 18 were rejected under 35 U.S.C. 102(e) as being anticipated

by U.S. Pat. App. No. 2001/0044324 by Carayiannis et al. (hereinafter "Carayiannis"), and rejected claims 4 and 15-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Carayiannis. The prior art reference of Iwase et al. (2002/0165803) was cited as being pertinent to the present application. This rejection has been carefully considered, but is most respectfully traversed.

The system (Fig. 1) for reading display information according to the invention, as now recited in claim 1, comprises: an information display member *A*; and at least one mobile communication terminal (page 20, line 3-4) of a public mobile communication system *B* (e.g., a PDC, CDMA, or GMS system, page 21, lines 5 and 9, including at least one mobile phone) for reading at least a portion of the display information *G* (e.g., text, image, and audio page 16, last paragraph) displayed on said information display member *A*. The information display member comprises an information recording element *R* (e.g., a IC chip *S* or a bar code *T*) in which necessary and/or optional information of the information portion is stored; said mobile communication system *B* comprises a reader mechanism *V* for reading information recorded in said information recording element *R* and a display mechanism *E* for displaying the read information; and the information recorded in said information recording element *R* including said portion of the display information *G* displayed on said information display member *A*. In particular, the information display member *A* is a poster, a signboard, a time table, a statement of virtues, a paper ad, a postcard, a handbill, tissue papers, an ad hung down in trains, or a mascot doll (page 15, lines 5-19). The information display member physically displays information perceivable and desired by a person who would otherwise write down the information of interest on a memo pad (page 2, line 18) but for the availability of the invention.

As shown in Fig. 3, the information recorded in said reader mechanism is transferred via a net line of a LAN (claim 4) to be recorded in a personal computer *I* or a server system *H* (Claim 5). The mobile communication system includes a mobile phone (Figs. 1 and 4; claim 13). The reader mechanism reads information from the information recording element in a contact or non-contact manner (Fig. 5; claim 14). The bar code is a stack type bar code or a data matrix bar code (page 14, line 15; claim 15), and the IC chip includes a coil antenna (page 11, line 13; Figs. 7 and 13; claims 16-17). The mobile communication system further comprises reading-out means for reading the text information into voice (page 26, 1st paragraph; claim 18) to serve blind people.

Applicants respectfully contend that neither Carayiannis nor any of the other cited references or their combinations, teaches or suggests that the information recording element *R* on an

information display member A being a poster, a signboard, a time table, a statement of virtues, a paper ad, a postcard, a handbill, tissue papers, an ad hung down in trains, or a mascot doll.

In contrast, Carayiannis only applies the information recording element, such as bar code 94, on a business card, i.e., a small card printed or engraved with a person's name and business affiliation, including such information as title, address, and telephone number.¹ As the specification provides very detailed descriptions of every embodiments of the invention known or envisioned to “intelligent devices, other than mobile phones ([0028]),” “types of output devices, in addition to, or in lieu of display 108 ([0029]),” “Other types of input devices, in addition to, or in lieu of keypad 112 ([0031]),” “a machine readable indicia other than a barcode ([0032]),” etc., Carayiannis does not intend to apply the information system beside business cards.

“When construing the language of the claims, intrinsic evidence such as the entire patent document (which includes the claims themselves, the drawings, and the specification) and the prosecution history, should be considered first. Intrinsic evidence is the most significant source of the legally operative meaning of the disputed claim language.” See Vitronics, 90 F.3d at 1582, 39 U.S.P.Q.2d at 1576. As such, the **ordinary meaning of business cards is presumed.** *“When first looking at the patent document itself, we begin with the language of the issued claims since “it is that language that the patentee chose to ‘particularly point[] out and distinctly claim[] the subject matter which [he] regards as his invention.”* Id., 59 U.S.P.Q.2d (BNA) at 1406 (citing 35 U.S.C. § 112). *“Deviations from the ordinary meaning of a claim term only occurs when the patentee uses “words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.”* Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1327, 63 U.S.P.Q.2d (BNA) 1374, 1382 (Fed. Cir. 2002). The courts increasingly consult dictionaries and technical treatises as a beginning point when searching for the ordinary meaning of a term. See, e.g., CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366, 1369-70, 62 U.S.P.Q.2d (BNA) 1658, 1662, 1665 (Fed. Cir. 2002) (citing numerous cases which relied on dictionary definitions to establish the ordinary meaning given a claim term by those skilled in the art); Optical Disc Corp. v. Del Mar Avionics, Inc., 208 F.3d 1324, 1335, 54 U.S.P.Q.2d (BNA) 1289, 1295 (Fed. Cir. 2000); Karlin Tech., Inc. v. Surgical Dynamics, Inc., 177 F.3d 968, 971, 50 U.S.P.Q.2d (BNA) 1465, 1468 (Fed. Cir. 1999).

Clearly, a business card, i.e., a small card printed or engraved with a person's name and business affiliation, including such information as title, address, and telephone number, is not a poster, a signboard, a time table, a statement of virtues, a paper ad, a postcard, a handbill, tissue

papers, an ad hung down in trains, or a mascot doll.

Applicants respectfully remind the Examiner that any reliance upon the “common knowledge and common sense” of one skilled in the art for the motivation for combining Carayiannis’ teachings with a poster, a signboard, a time table, a statement of virtues, a paper ad, a postcard, a handbill, tissue papers, an ad hung down in trains, or a mascot doll shall fulfill the agency’s obligation to cite references to support its conclusions by pointing out the specific teaching, e.g. *statements in the prior art*, of allegations of the combination on the record to allow accountability.

To establish a prima facie case of obviousness, the Board must, inter alia, show “some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). “The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved.” Kotzab, 217 F.3d at 1370, 55 USPQ2d at 1317. Recently, in In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), we held that the Board’s reliance on “common knowledge and common sense” did not fulfill the agency’s obligation to cite references to support its conclusions. Id. at 1344, 61 USPQ2d at 1434. Instead, the Board must document its reasoning on the record to allow accountability. Id. at 1345, 61 USPQ2d at 1435.

See In re Thrift, 298 F.3d 1357.

Applicants contend that none of the cited prior references teaches or discloses each and every feature of the present invention as disclosed in independent claim 1. As such, the present invention as now claimed is distinguishable and thereby allowable over the rejections raised in the Office Action. The withdrawal of the outstanding prior art rejections is in order, and is respectfully solicited.

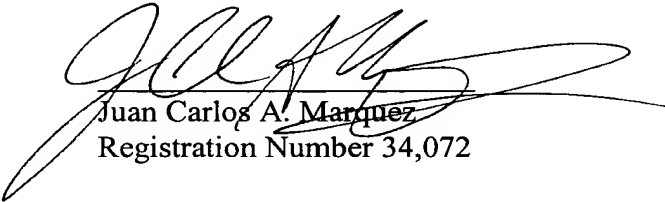
In view of all the above, clear and distinct differences as discussed exist between the present invention as now claimed in claim 1 and the prior art reference upon which the rejections in the Office Action rely, Applicants respectfully contend that the prior art references cannot anticipate the present invention or render the present invention obvious. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

¹ The American Heritage® Dictionary of the English Language <http://www.bartleby.com/61/39/B0573900.html>

Favorable reconsideration of this application is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicants' undersigned representative at the address and phone number indicated below.

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